

Rejections under 35 U.S.C. § 112, first paragraph- written description

Claims 55-57, 59-77, and 79-96 have again been rejected for alleged failure to fulfill the written description requirement. Additionally, claim 97 has been rejected for alleged failure to fulfill the written description requirement. Applicants will present arguments against this rejection in the forthcoming Appeal Brief.

Rejections under 35 U.S.C. § 112, first paragraph- enablement

Claims 54-57, 59-77, and 79-96 remain rejected for alleged failure to fulfill the enablement requirement. Applicants will present arguments against this rejection in the forthcoming Appeal Brief.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 90-96 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner contends that step (a) of claims 90-96 as previously presented is not clear because it does not require that the mammals have “a loss of proteoglycan, cleavage of type II collagen into a TCA degradation product...” as in the preamble of the claims. In response to this rejection, claims 90-96 (specifically, new step (b) of these claims) have been amended to specify the specific phenotypes (*i.e.*, those recited in the preamble). Accordingly, Applicants respectfully request withdrawal of this rejection.

In addition, the Examiner alleges that there appears to be a separate step in the phrase of “activating” MMP expression in the first and second mammal. Claims 90-96 have been amended to add step (b), which expressly recites “activating expression of the metalloproteinase...” Accordingly, Applicants respectfully request withdrawal of this rejection.

Lastly, the Examiner alleges that there is no antecedent basis for the phrase “phenotypic change” in the last “wherein” clause of claims 90-96. In response to this rejection, the

phrase “phenotypic change” has been replaced with the term “phenotype,” which has proper antecedent basis. Accordingly, Applicants respectfully request withdrawal of this rejection.

It is believed that the indefiniteness rejections have been obviated and Applicants respectfully request withdrawal of these rejections and entry of these amendments. Furthermore, entry of these amendments is respectfully requested in order to put the claims in better condition for appeal.

CONCLUSION

In view of the foregoing, it is believed that the indefiniteness rejections have been obviated and entry of the claim amendments is respectfully requested in order to place the claims in better form for consideration on appeal.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: January 2, 2005

Respectfully submitted,

By Heather Morehouse Ettinger
Heather Morehouse Ettinger

Registration No.: 51,658
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 753-6237 (Fax)
Attorneys/Agents For Applicant